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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,044	08/05/2003	Ryuta Sekine	16894	6986
23389	7590	12/15/2006		EXAMINER
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			SMITH, PHILIP ROBERT	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	10/635,044	Applicant(s)	SEKINE ET AL.
Examiner	Philip R. Smith	Art Unit	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on 21 November 2006.
- 2a)  This action is FINAL. 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-6,8-15,17-19,21-29 and 31-41 is/are pending in the application.
  - 4a) Of the above claim(s) 2,3,31-34,36 and 56 is/are withdrawn from consideration.
- 5)  Claim(s) 4 and 41 is/are allowed.
- 6)  Claim(s) 6,8-14,17,18,35 and 38 is/are rejected.
- 7)  Claim(s) 15,19,21-29,37,39 and 40 is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### Continued Examination Under 37 CFR 1.114

[01] A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/2006 has been entered.

### Claim Rejections - 35 USC § 102

[02] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

[03] Claims 1, 6, 8-14, 17-18, 35 & 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (6,119,913), for the reasons set forth in the previous Office Action, paper number 01092006.

[04] As noted in the Advisory Action of 10/24/2006, Adams discloses a "conventional endoscope 16" which is "articulated" (9/9), shown in Figure 9a. It is maintained that the second insertion instrument disclosed by Adams has a space, and that the first insertion instrument disclosed by Adams ("16") is "adapted to be bent in the space to a side opposite to the living tissue that is the object of treatment."

[05] It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It

does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

### **Allowable Subject Matter**

- [06] Claim 41 is allowed.
- [07] Claims 4, 15, 19, 21-29, 37, 39 & 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Response to Arguments**

- [08] Applicant's arguments filed 11/21/2006 have been fully considered but they are not persuasive.
- [09] In response to Applicant's argument that "Adams simply does not disclose or suggest lifting the tissue into the device by bending but by withdrawal of the endoscope into the device," it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Applicant's characterization of Adams' device is neither conceded nor disputed; it is respectfully maintained that the invention of Adams anticipates the claimed structural limitations. Namely, that the articulated endoscope disclosed by Adams is capable of the descriptive usage recited in claims 1 & 38.

### Conclusion

- [10] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [11] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [12] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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